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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,656	02/11/2002	Cory Watkins	1552-CA-2	6269
7590	12/16/2003		EXAMINER	
VP, General Counsel & Secretary AUGUST TECHNOLOGY CORP. 4900 West 78th Street Bloomington, MN 55435				SOHN, SEUNG C
		ART UNIT		PAPER NUMBER
				2878

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/073,656	WATKINS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Seung C. Sohn	2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 22 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-5 is/are pending in the application.
  - 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9/22/2003</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### *Election/Restrictions*

1. ***Claim 1 is withdrawn*** from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse on September 8, 2003.

### *Double Patenting*

2. ***Claims 1-5 of this application conflict with claims 1-5 of Application No. 10/073,613.*** 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. ***Claims 2-5 are provisionally rejected under 35 U.S.C. 101*** as claiming the same invention as that of claims 2-5 of copending Application No. 10/073,613. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

#### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: optical subsystem **124** disclosed in page 3, line 11 and page 4, line 8. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

6. ***Claims 2-5*** are objected to because of the following informalities:

On claim 2, line 3, "a surface" after "scanning" should be -- the surface --.

On claim 2, line 5, "the light intensity" after "measuring" should be changed to – a first light intensity – for clarity.

On claim 2, line 6, "the light intensity" after "measuring" should be changed to – a second light intensity – for clarity.

On claim 2, line 9, "the light intensities" before "measured" should be changed to -- the first and second light intensities -- for clarity.

On claim 3, line 2, "a surface" after "portions of" should be -- the surface --.

On claim 3, line 3, "a camera" before "capable of" should be changed to –the camera --.

On claim 3, line 5, "the light intensity" after "measuring" should be changed to – a third light intensity – for clarity.

On claim 3, line 6, "the light intensity" after "measuring" should be changed to – a fourth light intensity – for clarity.

On claim 3, line 8, "the light intensities" before "measured" should be changed to -- the third and fourth light intensities -- for clarity.

On claim 4, line 3, "a protrusion" after "the elevation of" should be changed to – the protrusion --.

On claim 5, line 4, "a beamsplitter" before "for receiving light" should be changed to – a pellicle beamsplitter – for consistency.

On claim 5, line 8, "a camera" before "for collecting focused light" should be changed to –the camera --.

On claims 2-5, the word "protrusion" should be changed to – bump – as on the preamble in claim 2, or vise versa, for consistency.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. ***Claims 2-5 are rejected under 35 U.S.C. 102(b) as being anticipated by***

***Kerstens et al. (Patent No. US 5,248,876).***

**Referring to claim 2,** Kerstens et al. discloses the following steps of Applicant's claim:

- a) scanning a surface using optics (lens) and a camera (CCD sensor) capable of determining light intensity for each pixel viewed (Col. 8, lines 26-34);
- b) measuring the light intensity at each pixel at a first elevation (Col. 7, lines 49-54);
- c) measuring the light intensity at each pixel at a second elevation (Col. 7, lines 49-54); and
- d) determining the elevation of the surface using a Gaussian curve based upon the light intensities measured at the first and second elevations at each pixel (Col. 7, lines 55-66).

**Referring to claim 3,** Kerstens et al. discloses following further steps of Applicant's claim:

- e) scanning at least particular portions of a surface believed to contain protrusions extending outward from the surface using optics and a camera capable of determining light intensity for each pixel viewed (Col. 8, lines 26-34);
- f) measuring the light intensity at each pixel at a third elevation (Col. 2, lines 30-41);

- g) measuring the light intensity at each pixel at a fourth elevation (Col. 2, lines 30-41); and
- h) determining the elevation of the protrusions using a Gaussian curve based upon the light intensities measured at the third and fourth elevations at each pixel (Col. 7, lines 55-66).

**Referring to claim 4**, Kerstens et al. discloses the step of determining the height of a protrusion by calculating the difference between the elevation of a protrusion and the elevation of the surface (Fig. 8, Col. 8, lines 38-65).

#### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. ***Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerstens et al. (Patent No. US 5,248,876) in view of Lam (Patent No. 5,408,294).***

**Referring to claim 5**, Kerstens et al. shows in Fig. 1 the following elements of Applicant's claim:

- a) a light source (100);
- b) a beamsplitter (106) for receiving light from the light source (100) and redirecting said light;

- c) an aperture array (116) for receiving light from the beamsplitter (106) (Col. 4, lines 40-44);
- d) at least one reimager (118) (Col. 4, lines 46-56); and
- e) a camera (114, i.e., CCD sensor) for collecting focused light.

Kerstens et al. discloses the claimed invention as set forth above, but does not disclose that the beamsplitter is pellicle beamsplitter. Lam shows in Fig. 1 the pellicle beamsplitter (64). It would have been obvious to one of ordinary skill in the art to provide the pellicle beamsplitter of Lam on the device of Kerstens et al. for the purpose of avoiding image displacement (Col. 7, lines 38-49).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seung C. Sohn whose telephone number is (703) 308-4093. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (703) 308-4852. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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